

REMARKS

SUMMARY OF AMENDMENTS

Upon entry of the present amendment claims 27-53 will be pending, with claims 27, 44 and 53 being independent claims. In this regard, claims 27-29, 35, 37-39, 42-45 and 50-52, in the given order, correspond generally to canceled claims 13-26. Support for new claims 27-53 can be found throughout the present specification and the canceled claims.

It is noted that the cancellation of claims 13-26 is without prejudice or disclaimer to the prosecution of these claims in one or more divisional and/or continuation applications.

RESTRICTION REQUIREMENT

The Examiner has required restriction to one of the following inventions:

Group I: Claims 13-21, drawn to a catalytic composition.

Group II: Claims 22 and 23, drawn to a process of making a catalytic composition.

Group III: Claims 24-26, drawn to a method of using a catalytic composition.

ELECTION

In order to be responsive to the requirement for restriction, Applicants elect, with traverse the invention set forth in claims 27-43 and 53 which correspond generally to the invention of Group I as identified in the Restriction Requirement.

TRAVERSE

Applicants respectfully submit that a restriction is inappropriate in this case.

The Restriction Requirement asserts that the inventions listed in Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they allegedly lack the same or corresponding special features. In this regard, the Restriction Requirement alleges that the common technical feature among the groups is the catalytic composition, but that this feature is not a special technical feature because it is allegedly anticipated by EP A 0 842 967 (which is a family member U.S. Patent No. 6,187,426 to Jonschker et al.).

Initially it is noted that for the purpose of a decision on the question of restriction the claims are ordinarily assumed to be patentable (novel and unobvious) over the prior art (see, e.g., MPEP § 806.02). For this reason alone, the Restriction Requirement should be withdrawn.

Further, Applicants respectfully disagree with the above assessment as to the alleged lack of a common special technical feature. In particular, the present independent claims recite “particles comprising at least one transition metal oxide which exhibits catalytic activity in at least one of a deodorization and an oxidation process”. The EP document does not mention any catalytic properties of the composite material disclosed therein, let alone catalytic properties of the colloidal inorganic particles used for the production of this

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composite. Rather, the EP document discloses that these colloidal inorganic particles are surface-modified by hydrolyzed and condensed silanes in order to prepare a nanocomposite sol (cf. claim 1), i.e., the particles are surface-modified and surrounded by the produced silane condensate. Additionally, the EP document focuses on partial or complete encapsulation of a substrate with a nanocomposite in order to impart particular properties to this substrate, "for example oxidation resistance, flame retardancy, hydrophobic or oleophobic character, hardness, impermeability, or electrical or thermal insulation" (see col. 5, lines 7-13 of the '426 patent). Accordingly, the EP document does not anticipate the claimed catalytic composition for at least the reasons set forth above. Withdrawal of the Restriction Requirement is warranted and respectfully requested also for this reason.

Further, in MPEP Chapter 800, the Office sets forth its policy by which examiners are guided in requiring restriction under 35 U.S.C. § 121. Section 803 states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

In the present case, a search for the catalytic composition of Group I should cover many areas which are relevant for the process of Group II and the method of Group III. Therefore, as a practical matter, the searches for the Groups should significantly overlap. Thus, the search burden would not be serious. Incidentally, the Restriction Requirement does

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not allege that there is a serious search burden, let alone explain why a serious burden allegedly exists. This is yet another reason why the Restriction Requirement should be withdrawn.

In summary, Applicants respectfully request that the Restriction Requirement be reconsidered and withdrawn, for at least the various reason set forth above.


The Examiner is reminded of the rejoinder practice set forth in MPEP § 821.04, i.e., if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend or otherwise include all of the limitations of the allowable product claim must be rejoined.

Should there be any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
Thomas BENTHIEN et al.



Neil F. Greenblum
Reg. No. 28,394



Reg. No. 50,417

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191